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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,215	04/12/2004	David S. Rathbun	001227/0129	1597
69095	7590	07/02/2007		
STROOCK & STROOCK & LAVAN, LLP 180 MAIDEN LANE NEW YORK, NY 10038			EXAMINER COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			07/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,215

Applicant(s)

RATHBUN ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44, 46-48 and 56-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-12, 19-44, 46-48 and 58-63 is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-18, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 April 2007 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 13-15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (6,342,057; cited by applicant).

Brace et al. disclose a drill guide 100 comprising a guide barrel, e.g. 136, joined to an alignment assembly 138 (see Figs. 1 and 2). The guide barrel has a bore and the alignment assembly comprises a plurality of resilient fingers 206 having a ridge at the distal end thereof for locking to a bone plate 254 having screw holes and a recess 252 (see Fig. 12). A handle 112, 114 is associated with the guide barrel and is rotatable with respect to the guide barrel in a first plane either taken through the handle and the barrel (i.e. movement or actuation of the handle members 112, 114) or taken

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perpendicularly to the axis of the barrel bore (i.e. rotation of the entire device about the axis of the barrel bore). The device includes a swivel assembly (e.g. 124, 158) having a locked and unlocked position. Any of the openings of the assembly such as the slot for portion 158 can be considered a drain hole. The location post is axially fixed to the alignment assembly.

Claims 1, 5, 6, 13, 14, 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (6,342,057; cited by applicant). (Note: this rejection differs from the rejection under 35 USC 102(b) over Brace et al. that was already applied above in the interpretation of the alignment assembly.)

Brace et al. disclose a drill guide 100 comprising a guide barrel, e.g. 136, joined to an alignment assembly (see Figs. 1, 2 and 7). The guide barrel has a bore and the alignment assembly includes a location post 138 slidably received within an axial bore of a housing 206 (see Fig. 7). The location post has an extended and retracted position relative to the housing. The end of the guide barrel can be considered a depth stop since it is a surface that is capable of preventing a corresponding tool from passing therebeyond. A handle 112, 114 is associated with the guide barrel and is rotatable with respect to the guide barrel in a first plane either taken through the handle and the barrel (i.e. movement or actuation of the handle members 112, 114) or taken perpendicular to the axis of the barrel bore (i.e. rotation of the entire device about the axis of the barrel bore). The device includes a swivel assembly (e.g. 124, 158) having a locked and unlocked position. Any of the openings of the assembly such as the slot for portion 158 can be considered a drain hole.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for the obviousness rejections under this section of the Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brace et al. (6,342,057; cited by applicant).

Brace et al. disclose the claimed invention except for explicitly disclosing the device comprising a non-metallic bearing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device with a bearing of a known material other than metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 7-12, 19-44, 46-48 and 58-63 are allowable.

Response to Arguments

Applicant's arguments filed 18 April 2007 have been fully considered but they are not persuasive.

Applicant's argument regarding claim 1 is not persuasive. As set forth, Brace et al. satisfies the limitation that "the guide barrel is not capable of being pivotable relative to the alignment assembly," since the device of Brace et al. may be locked at a particular angle (see, e.g., col. 6, lines 19-28 and col. 12, lines 37-39). Thus, the device

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is not capable of being pivotable when locked. Applicant correctly argues that the device of Brace et al. is adjustable and this aspect of the invention is beneficial to the surgeon. More importantly, applicant uses the "open" claim transition "comprising," which requires at least the limitations or capabilities that are set forth but does not preclude additional limitations or capabilities. A locking capability is not contrary to any of Applicant's claims. It is an additional advantageous feature of the device of Brace et al. The device of Brace et al. is explicitly capable of being locked such that the guide barrel is not pivotable relative to the alignment assembly. Thus, it meets the limitation "not capable of being pivotable" as set forth in claim 1. *In addition to* this, the device of Brace et al. *also* provides the capability of being adjusted. Therefore, the device of Brace et al. is *not* inapposite and comprises at least everything that is claimed. It is noted that Applicant's claims 15 and 33 would be unclear and inconsistent, applying Applicant's own logic from above to the specific limitations in those claims. Specifically, if the handle recited therein is "freely rotatable with respect to the guide barrel" as claimed, then it would not also be able to satisfy the limitation that it "can not [be] rotated with respect to the guide barrel" (sic). Of course, these claims are not inconsistent because the device has a locked position and an unlocked position. Likewise, the device of Brace et al. comprises a locked position and an unlocked position, and in a locked position the guide barrel is not capable of being pivotable relative to the alignment assembly.

Regarding amended independent claim 56, the location post of the device of Brace et al. has a longitudinal axis and is clearly pivotable about the same. It is noted

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that the location post is also pivotable in a bone plate recess; that is, it can be placed in a bone plate recess and, *together with the plate*, can be pivoted. Furthermore, when not fully engaged therein, it can also rotate relative to the plate.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



EDUARDO C. ROBERT
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